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EXAMINER FONSECA, JESSIE T				
ART UNIT 3633		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DL.NYDOCKET@BAKERBOTTS.COM

# Office Action Summary

**Application No.**

10/517,350

**Applicant(s)**

GARDNER, DONALD PAUL

**Examiner**

JESSIE FONSECA

**Art Unit**

3633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7, 9-15 and 18-26 is/are pending in the application.
- 4a) Of the above claim(s) 22 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 9-15, 18-21 and 24-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5 February 2009.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/5/09 has been entered.

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-5, 7, 9-15, 18-21, and 24-26 are drawn to a ventilating flooring covering having studs.

Group II, claim(s) 22-23, drawn to a method of making a ventilating floor covering having studs.

The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the common technical feature in all groups is the studs. This element cannot be a special technical

feature under PCT Rule 13.2 because the element is shown in the prior art. GB 690,863 discloses a decorative floor covering having studs for use in ventilating a floor covering.

Newly submitted claims 22-23 are directed to an invention wherein the common technical feature with claims 1-5, 7, 9-15, 18-21 and 24-26 are the studs, which is not considered a special technical for the reasons stated above.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 22-23 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Drawings***

The drawings were received on 2/5/09. These drawings are not acceptable.

The claimed feature not shown is to a floor covering being wound onto a core. The replacement drawing shows a floor covering being wound, however, no core is present in which the covering is wound onto.

The previous drawing objection has been reiterated below.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the floor covering wound onto a core (claims 20-21) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claim 7 is objected to because of the following informalities:

Line 2: The limitation "the floor covering which material" appears incomplete. Examiner suggest amending the limitation to read as -- the floor covering in which the particulate material--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7 and 25-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 is dependent upon canceled claim 6. It appears claim 7 should be dependent upon claim 1? Claim 7 is examined as best understood.

With regards to claims 25-26: Each claim recites the top layer as if they were a separate layer from the claimed wear layer, it appears the two layers are one in the same. Claims 25-26 are examined as best understood.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 102***

Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Kotler (US 4,860,510).

With regards to claim 18: Kotler discloses a combination of a floor having an upper surface (col. 1, line 10-14) and a slip resistant ventilating decorative floor covering (10) for loose laying on the upper surface of the floor wherein the floor covering is a single sheet plastics floor covering (col. 4, line 65 – col. 5, line 6; and col. 5, lines 41-45) and has a decorative upper surface (col. 5, lines 16-19) and a lower surface on which are formed one or more studs (9) so that an air gap is formed between the lower

surface of the floor covering and the upper surface of the floor sufficient to ventilate the floor (col. 1, lines 6-14).

Examiner notes the limitation regarding the one or more studs being embossed from the lower surface is a product by process limitation.

Determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. MPEP 2113.

***Claim Rejections - 35 USC § 103***

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kotler (US 4,860,510) in view to Fanti (US 2001/0034983 A1).

With regards to claim 19: Kotler discloses a ventilating decorative floor covering (10) being a plastics floor covering (col. 4, line 65 – col. 5, line 6; col. 5, lines 41-45) and having a decorative upper surface and a lower surface on which are formed one or more studs (19) (figs. 1-2) (col. 5, lines 16-19).

The floor covering of Kotler is capable of loose laying on an upper surface of a floor so that, in use, an air gap is formed between the lower surface of the floor covering and the upper surface of the floor sufficient to ventilate the floor. Note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed

invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Kotler, discloses everything previously mentioned, but fails to disclose the lower surface being modified to ensure that there is adequate grip between the lower surface of the floor covering and the floor to which is applied.

However, Fanti discloses a flooring covering (par. 0001) having a roughened lower surface to enhance the securement of the flooring to the surface in which it is to be laid (par. 0015).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the floor covering of Kotler to include a roughened lower surface as taught by Fanti in order to provide a lower surface having a greater coefficient of friction with the surface in which it was laid for increased stability and securement.

Claims 1-3, 5, 7, 9, 11-14, 18-19, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shortland et al. (WO 00/42274) in view of Oakley (GB 690,863).

With regards to claim 1: Shortland et al. discloses a decorative single sheet plastics floor covering comprising a decorative upper surface (fig. 1; pg. 1, lines 1-5; pg. 6, lines 21-25), wherein the flooring covering includes one or more particulate materials in the decorative upper surface of the flooring covering to provide slip resistance (pg. 2, lines 10-20).



Shortland et al. discloses everything previously mentioned, but fails to disclose one or more studs formed on the lower surface of the floor covering.

However, Oakley discloses flooring having one or more studs formed on the lower surface so as to provide ventilation (col. 4, lines 71-78; figs. 1-4).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the floor covering of Shortland et al. to include one or more studs formed on the lower surface of the floor covering as taught by Oakley in order to provide means for increased ventilation so as to mitigate moisture due to sweating of concrete or humidity within the air (col. 4, lines 71-78).

The floor covering of Shortland et al., in view of Oakley, is capable of loose laying on an upper surface of a floor so that, in use, an air gap is formed between the lower surface of the floor covering and the upper surface of the floor sufficient to ventilate the floor. Note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Examiner notes the limitation regarding the one or more studs being embossed from the lower surface is a product by process limitation.

Determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is

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unpatentable even though the prior product was made by a different process. MPEP 2113.

With regards to claims 2, 3, & 5: Shortland et al. further discloses the modification of the floor surface (1) in the form of a softening agent, such as a plasticizer (page 8, lines 5-10). As disclosed by the applicant on lines 24-26, page 3 of the disclosure, the lower surface can be softened using a plasticizer. It is noted that any amount of plasticizer other than the minimum amount used is considered additional plasticizer.

With regards to claim 7: Shortland et al. further discloses the particulate material (6) is embedded in the decorative upper surface of the flooring covering (1) is at least partially protruding from the upper surface to achieve adequate slip resistance (fig. 1; col. 3, lines 7-15).

With regards to claim 9: Shortland et al. further discloses the plastics material is selected from a group consisting of PVC, plasticized acrylic, polyester, and a PVC plastisol material (fig. 1; pg. 3, lines 7-15).

With regards to claim 11: Shortland et al., further discloses the floor covering is heterogeneous flooring covering made up from a plurality of layers (fig. 1).

With regards to claim 12: Shortland et al. further discloses a wear layer (3) (fig. 1).

With regards to claim 13: Shortland et al. further discloses a pigment (pg. 8, lines 6-8) and pigmented PVC chips (pg. 3, lines 20-23).

With regards to claim 14: Shortland et al. further discloses a reinforcing support, preferably a glass fibre reinforced non-woven support (page 2, lines 21-22).

With regards to claim 18: Shortland et al. discloses a floor covering (1) having a decorative upper surface (page 3, lines 7-11) and a lower surface (fig. 1).

Shortland et al. discloses everything previously mentioned, but fails to disclose one or more embossed studs formed on the lower surface of the floor covering, where an air gap is formed between the lower surface of the floor covering and the upper surface of the floor

However, Oakley discloses flooring tile having one or more studs formed on the lower surface so as to provide ventilation when laying the floor covering on a floor (col. 1, lines 9-11; col. 4, lines 71-78).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the floor covering of Shortland et al. to include one or more studs formed on the lower surface of the floor covering as taught by Oakley in order to provide a means for increased ventilation so as to mitigate moisture due to sweating of concrete or humidity within the air (col. 4, lines 71-78).

Examiner notes the limitation regarding the one or more studs being formed by embossment of the lower surface renders the claims a product by process limitation.

Determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is

unpatentable even though the prior product was made by a different process. MPEP 2113.

With regards to claim 19: Shortland et al. discloses a slip resistant decorative single sheet heterogeneous plastics floor covering comprising a decorative upper surface (fig. 1; pg. 1, lines 1-5; pg. 6, lines 21-25), to provide slip resistance (pg. 2, lines 10-20).

Shortland et al. discloses everything previously mentioned, but fails to disclose one or more studs formed on the lower surface of the floor covering.

However, Oakley discloses flooring having one or more studs formed on the lower surface so as to provide ventilation (col. 4, lines 71-78; figs. 1-4).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the floor covering of Shortland et al. to include one or more studs formed on the lower surface of the floor covering as taught by Oakley in order to provide means for increased ventilation so as to mitigate moisture due to sweating of concrete or humidity within the air (col. 4, lines 71-78).

The floor covering of Shortland et al., in view of Oakley, is capable of loose laying on an upper surface of a floor so that, in use, an air gap is formed between the lower surface of the floor covering and the upper surface of the floor sufficient to ventilate the floor. Note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Shortland et al. further discloses the modification of the floor surface (1) in the form of a softening agent, such as a plasticizer (page 8, lines 5-10). As disclosed by the applicant on lines 24-26, page 3 of the disclosure, the lower surface can be softened using a plasticizer.

Examiner notes the limitation regarding the one or more studs being embossed from the lower surface is a product by process limitation.

Determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. MPEP 2113.

With regards to claims 24-25: Shortland et al. further discloses a top layer (3) including the decorative upper surface which includes one or more particulate materials (6) (fig. 1).

As per the modification of claim 1, the base layer (lower surface of floor covering) would include studs as taught by Oakley.

As noted in the rejection of claim 1, the limitation regarding the one or more studs being embossed from the lower surface is a product by process limitation.

With regards to claim 26: Shortland et al. further discloses a wear layer (3) including the decorative upper surface which includes one or more particulate materials (6) and a support (glass fibre reinforced non-woven support: page 2, lines 21-22) .

As per the modification of claim 1, the base layer (lower surface of floor covering) would include studs as taught by Oakley.

As noted in the rejection of claim 1, the limitation regarding the one or more studs being embossed from the lower surface is a product by process limitation.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shortland et al. (WO 00/42274) in view of Oakley (GB 690,863), and in further view of Fanti (US 2001/0034983 A1) and Daugherty et al. (US 5,597,194).

With regards to claim 4: Shortland, in view of Oakley, discloses everything previously mentioned, but fails to disclose the being the lower surface being roughened chemically using a blowing agent to ensure that there is adequate grip between the lower surface of the floor covering and the floor to which is applied.

However, Fanti discloses a flooring covering (par. 0001) having a roughened surface lower surface to enhance the securement of the flooring to the surface in which it is to be laid (par. 0015).

Daugherty et al. discloses a plastic net that is high friction and non-slip, where a surface of the net includes a component blend having a blowing agent that creates a roughened pattern for placement on truck bed (abstract & claim 10).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the floor covering of Shortland et al., in view of Oakley, to include a roughened lower surface as taught by Fanti, where the roughened surface is created by inclusion of blowing agent as taught by Daugherty et al. in order to provide a lower

surface having a greater coefficient of friction with the surface in which it was laid for increased stability and securement. The chemical modification of the lower surface of the floor covering will allow for increased time and cost savings as no additional steps would be required when compared to that of mechanical modification.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shortland et al. (WO 00/42274) in view of Oakley (GB 690,863), and in further view of Bergishagen (US 5,063,251).

With regards to claim 10: Shortland et al. further discloses the plastics material is in the amount of 100 to 200 parts per hundred part of plastics material (php), a filler preferably in the amount of 0 to 100 php, thermal stabilizer preferably in an amount of 1 to 3 php, and/or a pigment preferable in amount of 1 to 3 php (page 8, lines 5-8). It is noted that the Examiner considers the unit, Phr (parts per hundred of resin), to be equivalent to unit, Php (parts per hundred parts of plastic), as both pertain to a plastisol material.

Shortland et al., previously modified by Oakley, discloses everything previously mentioned, but fails to disclose a blowing agent in an amount of 0 to 2 php.

However, Bergishagen discloses a blowing agent for use with flooring tile (col. 1, lines 33-35), where a cell structure is formed when a blowing agent is used with conjunction of plastic material (col. 1, line 59 - col. 2, lines 4). Bergishagen further discloses a blowing agent preferably in an amount from 0 to 2 php (col. 4, lines 44-61).

It would obvious to one of ordinary skill in the art at the time of the invention was made to modify the floor covering of Shortland et al., in view of Oakley, to include a blowing agent in the amount of 0 to 2 php as taught by Bergishagen in order to expand of the floor covering plastic material for a light-weight plastic foam structure when compared to conventional plastic flooring material covering an identical area.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shortland et al. (WO 00/42274) in view of Oakley (GB 690,863), and in further view of Eckert et al. (US Re. 34,357).

With regards to claim 15: Shortland et al. discloses a slip resistant floor covering (1) having a decorative upper surface (page 3, lines 7-11) and a lower surface (fig. 1).

Shortland et al. discloses everything previously mentioned, but fails to disclose one or more studs formed on the lower surface of the floor covering, where an air gap is formed between the lower surface of the floor covering and the upper surface of the floor.

However, Oakley discloses flooring tile having one or more embossed studs formed on the lower surface so as to provide ventilation when laying the floor covering on a floor (col. 1, lines 9-11; col. 4, lines 71-78).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the floor covering of Shortland et al. to include one or more studs formed on the lower surface of the floor covering as taught by Oakley in



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order to provide means for increased ventilation so as to mitigate moisture due to sweating of concrete or humidity within the air (col. 4, lines 71-78).

Shortland et al., in view of Oakley, discloses everything previously mentioned, but fails to disclose loose laying the floor covering on the upper surface of a floor.

However, it is well known in the flooring art to loose lay flooring without the use of bonding material or other fastening methods such as taught by Eckert et al. (col. 1, lines 23-49).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to method of Shortland et al., previously modified by Oakley, to be loose-laid as taught by Eckert et al. in order to provide a flooring that can be installed and removed with ease.

Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shortland et al. (WO 00/42274) in view of Oakley (GB 690,863) and in further view of Tyson (US 4,444,313).

With regards to claim 20: Shortland et al., in view of Oakley, discloses everything previously mentioned, but fails to disclose the floor covering is wound onto a core.

However, Tyson discloses that is well known in the art that various goods come in rolls include paper, textile, carpets, floor covering and the like (col. 1, lines 15-18). Tyson further discloses a roll product wound onto a core for combined storage, shipping, display, and dispensing (figs. 1-11)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the floor covering of Shortland et al., previously modified by Oakley, to have a floor covering wound onto a core as taught by Tyson in order to provide a floor covering that is presented in a form that is easy to handle and transport.

With regards to claim 21: Shortland et al. discloses a decorative single sheet plastics floor covering comprising a decorative upper surface (fig. 1; pg. 1, lines 1-5; pg. 6, lines 21-25).

Shortland et al. discloses everything previously mentioned, but fails to disclose one or more studs formed on the lower surface of the floor covering.

However, Oakley discloses flooring having one or more studs formed on the lower surface so as to provide ventilation (col. 4, lines 71-78; figs. 1-4).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the floor covering of Shortland et al. to include one or more studs formed on the lower surface of the floor covering as taught by Oakley in order to provide means for ventilation (col. 4, lines 71-78).

Shortland et al., in view of Oakley, discloses everything previously mentioned, but fails to disclose the floor covering is wound onto a core.

However, Tyson discloses that is well known in the art that various goods come in rolls include paper, textile, carpets, floor covering and the like. Tyson further discloses a roll product wound onto a core for combined storage, shipping, display, and dispensing (figs. 1-11)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the floor covering of Shortland et al., previously modified by Oakley, to have a floor covering wound onto a core as taught by Tyson in order to provide a floor covering that is presented in a form that is easy to handle and transport.

The floor covering of Shortland et al., in view of Oakley and Tyson, is capable of loose laying on an upper surface of a floor so that, in use, an air gap is formed between the lower surface of the floor covering and the upper surface of the floor sufficient to ventilate the floor. Note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

### **Response to Arguments**

Applicant's arguments with respect to claims 1-3 and 11-15 to Kotler have been considered but are moot in view of the new ground(s) of rejection.

However, with respect to claim 18, applicant argues that Kotler fails to disclose the studs are embossed from the lower surface, but instead discloses the studs (support legs) are forming by injection molding.

Applicant's arguments are directed to how the studs are formed when the claims are directed to the article of the flooring covering. Determination of patentability is based on the product itself. The patentability of a product does not depend on its method of

production. If the product in the product-by- process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. MPEP 2113.

Further, Examiner submits that studs of Kotler are considered embossed from the lower surface as they extend or are protuberant to the lower surface of the floor covering. Dictionary.com defines *emboss* as " to raise or represent (surface designs) in relief."

Applicant further argues that Kotler fails to disclose one or more particulate material in the decorative upper surface to provide slip resistance.

Examiner notes that claim 18 has not been amended to include such a limitation.

Applicant further argues that Kotler fails to disclose or suggest a single sheet floor covering.

As noted in prior Office Action, a single tile of Kotler is considered a single sheet plastic covering which is capable of loose laying on an upper surface of a floor.

With respect to claim 19, applicant argues the teaching of Fanti is not relevant to the flooring of Kotler as the respective floorings are constructed in a completely different way. Applicant submits that par. 0027 of Fanti discloses that during the bonding process, the lower surface is roughened by mean of rubber press.

Examiner submits par. 0027 is referring to contact of the joining film and plastics covering, the cited paragraph does not recite the roughening is a result of the press. Examiner notes that the lower surface is roughened before the covering is laid and that joining film is not even a required component (par. 0015).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Oakley discloses the application of studs for flooring in order to provide ventilation for mitigating moisture due to sweating of concrete or humidity within the air (col. 4, lines 71-78).

Applicant submits a skilled person would not have been motivated to combine the teachings of Shortland et al. and Oakley because it would not have been expected that providing studs on the lower surface of a plastics floor covering would provide adequate ventilation.

Examiner disagrees, Oakley specifically discloses the studs form air ducts for ventilation. Given the disclosure of Oakley, one of ordinary skill in the art at the time of the invention would recognize the inclusion of studs is applicable to flooring placed on a concrete floor.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant further argues there is no disclosure in Shortland that the amount of plasticizer used would be sufficient in providing adequate grip between the lower surface of the floor covering and the floor to which it is applied.

As noted in the rejection, applicant in lines 24-26, page 3 of the disclosure discloses the lower surface can be softened using a plasticizer. Examiner submits that claims do not specify the amount of plasticizer used nor the degree of grip (coefficient of friction) obtained. As Shortland et al. discloses the use of plasticizer which is the chemical used by applicant for softening, the plasticizer of Shortland et al. would be expected to provide softening of the flooring as well and thus some degree of grip.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant's arguments with respect to claim 20-21 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Long discloses a ventilating covering having studs formed by an embossing roll (US 3,387,420).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSIE FONSECA whose telephone number is (571)272-7195. The examiner can normally be reached on M-F 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Canfield can be reached on (571)272-6840. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. F./  
Examiner, Art Unit 3633  
/Robert J Canfield/  
Supervisory Patent Examiner, Art Unit 3635